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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/181,585 10/28/98 RANUM

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EXAMINER

SOUAYA, J

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ART UNIT

PAPER NUMBER

1655

11

DATE MAILED:

08/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/181,585

Applicant(s)

Ranum et al

Examiner

Jehanne Souaya

Group Art Unit

1655



☒ Responsive to communication(s) filed on May 30, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 7-19, and 21-51 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 35 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Currently, claims 1-4, 7-19, and 21-51 are pending in the instant application. All the amendments and arguments have been thoroughly reviewed but are deemed insufficient to place this application in condition for allowance. Response to Applicant's arguments follow. This action is FINAL.

Maintained Rejections

2. Claim 35 is rejected under 35 U.S.C. 102(a) as being anticipated by accession # AL008632, Mistry, S. (Author).

The claim is directed to an isolated oligonucleotide that hybridizes to a repeat region of an isolated SCA8 coding sequence. Accession # AL008632 discloses an oligonucleotide that contains 20 nucleotides exactly complementary to SEQ ID NO 1. Nucleic acid hybridization is dependent on salt concentration, oligonucleotide composition, and temperature. Consequently, a nucleic acid sequence can hybridize to another nucleic acid sequence depending on the reaction conditions of the hybridization reaction. This rejection can be overcome by reciting instead "an isolated oligonucleotide that specifically hybridizes to a nucleic acid molecule...".

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Response to Arguments

The arguments and amendments have been thoroughly reviewed but were found non persuasive because the disclosure of accession # AL008632 inherently comprises an oligonucleotide that hybridizes to a nucleic acid molecule comprising a repeat region of an isolated SCA8 coding sequence. The recitation of "specifically hybridizes" would overcome the rejection.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

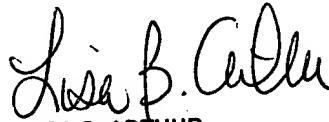
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703)308-6565. The examiner can normally be reached Monday-Thursday from 7:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.


LISA B. ARTHUR
PRIMARY EXAMINER
GROUP 1800-1600


Jehanne Souaya
Patent examiner
August 10, 2000